

## Request for Reconsideration after Final Action

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| SERIAL NUMBER  | 86135128       |
| LAW OFFICE ASSIGNED  | LAW OFFICE 104 |
| MARK SECTION (no change)   |                |
| ARGUMENT(S)  |                |
| <p><b>1. Refusal – Trademark Act § 2(d) – Likelihood of Confusion</b></p> <p>Applicant received a Final Office Action on October 16, 2014. The Examining Attorney has refused registration of the applied-for mark under Trademark Act Section 2(d), 15 U.S.C. § 1052, because of a likelihood of confusion with the marks in U.S. Registration Nos. 3655451, 3688377, and 4379914. The first two registrations are owned by the same entity (“Registrant No. 1”) and the third registration is owned by another entity (“Registrant No. 2”). (Office Action, October 16, 2014, p. 3). Applicant respectfully disagrees that the registered mark is confusingly similar to Registrant’s mark under Section 2(d).</p> <p>Likelihood of confusion between two marks is determined on a case-by-case basis by a review of all relevant factors under the <i>DuPont</i> test. <i>In re E.I. du Pont de Nemours &amp; Co.</i>, 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973). Specifically, the following thirteen factors are useful in determining whether a likelihood of confusion exists between the registered mark and the mark under examination:</p> <ol style="list-style-type: none"><li>1. The similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation, and commercial impression.</li><li>2. The similarity or dissimilarity and nature of the goods . . . described in an application or registration or in connection with which a prior mark is in use.</li><li>3. The similarity or dissimilarity of established, likely-to-continue trade channels.</li><li>4. The conditions under which and buyers to whom sales are made, i.e. "impulse" vs. careful, sophisticated purchasing.</li><li>5. The fame of the prior mark.</li><li>6. The number and nature of similar marks in use on similar goods.</li><li>7. The nature and extent of any actual confusion.</li><li>8. The length of time during and the conditions under which there has been</li></ol> |                |

concurrent use without evidence of actual confusion.

9. The variety of goods on which a mark is or is not used.
10. The market interface between the applicant and the owner of a prior mark.
11. The extent to which applicant has a right to exclude others from use of its mark on its goods.
12. The extent of potential confusion.
13. Any other established fact probative of the effect of use.

*In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361 177 USPQ 563, 567 (CCPA 1973). The two key considerations in ex parte likelihood of confusion analysis are the similarity of the marks and the similarity of the goods. *See Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976). Not all of the *DuPont* factors may be relevant or of equal weight in a given case, and any one of the factors may control a particular case depending on the evidence of record. *Citigroup Inc. v. Capital City Bank Grp., Inc.*, 637 F.3d at 1355, 98 USPQ2d at 1260; *In re Majestic Distilling Co.*, 315 F.3d 1311, 1315, 65 USPQ2d 1201, 1204 (Fed. Cir. 2003); *see In re E. I. du Pont de Nemours & Co.*, 476 F.2d at 1361-62, 177 USPQ at 567.

In the present dispute, the most important *DuPont* factors are 1, 2, and 8. Each will be discussed in turn.

**A. The similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation, and commercial impression.**

Applicant's mark "COYOTES ICE SPORTS" has a different sound, appearance, and connotation from Registrant's marks. Examining Attorney errs by placing too much weight on the common material, to the point that Examining Attorney effectively fails to consider the marks as a whole. Instead, the Examining Attorney relies only on the material in common, and does not analyze the material differences between the marks. Even if the analysis did properly consider the marks as a whole, it did not correctly identify the dominant portion of the marks.

In failing to analyze the marks as a whole, the Examining Attorney gave no weight to disclaimed material. The law is long settled that a disclaimer does not remove the disclaimed matter from the mark. The mark must still be regarded as a whole, including the disclaimed matter, in evaluating similarity to other marks. *See In re Nat'l Data Corp.*, 753 F.2d 1056, 1059, 224 USPQ 749, 751 (Fed. Cir. 1985); *Specialty Brands, Inc. v. Coffee Bean Distribs., Inc.*, 748 F.2d 669, 672, 223 USPQ 1281, 1282 (Fed. Cir. 1984); *Giant Food, Inc. v. Nation's Foodservice, Inc.*, 710 F.2d 1565, 1570, 218 USPQ 390, 395 (Fed. Cir. 1983); *Schwarzkopf v. John H. Breck, Inc.*, 340 F.2d 978, 144 USPQ 433 (C.C.P.A. 1965); *In re MCI Commc'ns Corp.*, 21 USPQ2d 1534, 1538-39 (Comm'r Pats. 1991). "The commercial impression of a trade-mark is derived from it as a whole, not from its elements separated and considered in detail. For this reason it should be considered in its entirety ....") *Estate of P.D. Beckwith, Inc., v. Commissioner of Patents*, 252 U.S. 538, 545-46, 40 S. Ct. 414, 64 L. Ed. 705 (1920). *Massey Junior College, Inc. v. Fashion Institute of Technology*, 492 F.2d 1399, 181 U.S.P.Q. 272 (C.C.P.A. 1974). See

also, *Franklin Mint Corp. v. Master Mfg. Co.*, 667 F.2d 1005, 212 U.S.P.Q. 233 (C.C.P.A. 1981) (“It is axiomatic that a mark should not be dissected and considered piecemeal; rather, it must be considered as a whole in determining likelihood of confusion.”); and *Sun-Fun Products, Inc. v. Suntan Research & Development, Inc.*, 656 F.2d 186, 213 U.S.P.Q. 91 (5th Cir. 1981) (the test is “overall impression,” not a “dissection of individual features”).

In the previous Office Actions, the Examiner did not consider the overall impression that W, OUTDOORS, RED, or the design portion of a fox contributed to the marks. Instead the Examining Attorney stated:

Registrant No. 1’s other mark, W COYOTE, has no disclaimed words. Applicant’s mark merely discards the letter W in Registrant No. 1’s mark and adds the descriptive words ICE SPORTS. Adding a term to a registered mark generally does not obviate the similarity between the compared marks, as in the present case, nor does it overcome a likelihood of confusion under Section 2(d). See *Coca-Cola Bottling Co. v. Jos. E. Seagram & Sons, Inc.*, 526 F.2d 556, 557, 188 USPQ 105, 106 (C.C.P.A. 1975) (finding BENGAL and BENGAL LANCER and design confusingly similar).

Likewise, Registrant No. 2’s mark, RED COYOTE, has no disclaimed words. Applicant’s mark merely discards the word RED in Registrant No. 2’s mark and adds the descriptive words ICE SPORTS. Again such a substitution does not obviate the similarity between the compared marks, nor does it overcome a likelihood of confusion under Section 2(d).

(October 16, 2014, Final Office Action, page 5.)

The problem with the Examiner’s analysis and reliance on *Coca-Cola Bottling Co. v. Jos. E. Seagram & Sons, Inc.* is that, in that case, the dominant portion of the mark was also the first portion of the mark. There, the Applicant merely added a modifying word to the end of a mark, where the first portion of the mark was the dominant portion. Besides, simply because two marks share similar portions is not the test of whether likelihood of confusion exists. *Conde Nast Publications, Inc. v. Miss Quality, Inc.*, 507 F.2d 1404, 184 U.S.P.Q. 422 (C.C.P.A. 1975) (COUNTRY VOGUES not confusingly similar to VOGUE); *In re Merchandising Motivation, Inc.*, 184 U.S.P.Q. 364 (T.T.A.B. 1974) (there is no absolute rule that no one has the right to incorporate the total mark of another as a part of one’s own mark: MMI MENSWEAR not confusingly similar to MEN’S WEAR); *Plus Products v. General Mills, Inc.*, 188 U.S.P.Q. 520 (T.T.A.B. 1975) (PROTEIN PLUS and PLUS not confusingly similar).

Here, Applicant’s did not merely append a word to the end of either Registrant’s mark, but instead seek registration of a mark with a different first portion and different final portion than either of them. It has long been settled the dominant portion of a literal mark is most often the first portion because it is the portion that is most likely to stick into consumer’s minds.

Applicant respectfully asserts that the dominant portion of the marks to Registrant No. 1 is the “W” portion of the mark based on its larger size than any other letter and its position at the beginning of the mark. Applicant respectfully asserts that the dominant portion of the mark to Registrant No. 2 is the first

literal element RED or the graphical portion of the mark based on its larger size and the distinctive character of the design.

**The first portion of a mark should be given greater weight.**

The Examining Attorney instead held that the literal portions of the marks , COYOTE, is the dominant portion of the registered marks. However, it has long been settled that consumers are most likely to focus on the *first part* of a mark.

“[T]here is more apt to be infringement where there is similarity, ...in the front part of the trademark. That part comes first, is the most prominent, and it is likely to be dominating.” *Coca-Cola Co. v. Carlisle Bottling Works*, 43 F.2d 101 (E.D. Ky. 1929), *aff’d*, 43 F.2d 119 (6th Cir. 1930), *cert. denied*, 282 U.S. 882, 75 L. Ed. 778, 51 S. Ct. 86 (1930). See also, *Presto Products, Inc. v. Nice-Pak Products, Inc.*, 9 U.S.P.Q.2d 1895 (T.T.A.B. 1988) (“[I]t is often the first part of a mark which is most likely to be impressed upon the mind of a purchaser and remembered.” *KID-WIPES* held confusingly similar to *KID STUFF* both for baby wipes.); *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 U.S.P.Q.2d 1689 (Fed. Cir. 2005) (In the mark VEUVE CLIQUOT, VEUVE is a "prominent feature" because it is the first word in the mark as well as the first word to appear on the wine label.); *In re Paper Doll Promotions, Inc.*, 84 U.S.P.Q.2d 1660, 2007 WL 2344667 (T.T.A.B. 2007) (first part of mark is dominant: likelihood of confusion in PAPER DOLL (and design) v. PAPER DOLL PROMOTIONS); *Eveready Battery Company, Inc. v. Green Planet, Inc.*, 91 U.S.P.Q.2d 1511, 2009 WL 2176668 (T.T.A.B. 2009) (That the word SLICK is first in the accused mark SLICK ULTRA PLUS is evidence that it is the dominant part. A likelihood of confusion with the senior user's SCHICK was found for the same goods.)

Accordingly, the present case is similar to the *KID-WIPES*, *VEUVE CLIQUOT*, and *PAPER DOLL PROMOTIONS* cases, because the dominant portion of the marks is the first portion. Therefore, consumers would focus on the W portion of Registrant No. 1's marks and the RED portion of Registrant No. 2's mark, not on the COYOTE portion of those marks. The W and RED portion of those marks form the dominant portion of those marks.

Therefore, Applicant respectfully asserts that when the dominant portions of the marks are compared, COYOTES, of Applicant's mark with W and RED of Registrants' marks, no likelihood of confusion can be found.

**The largest portion of a mark should be given greater weight.**

If the Examining Attorney looks to size as to determine the dominant portion of the mark, the W portion of Registrant No. 1's marks is much larger than any other character of the marks. (It is at least three times as big as any other letter). Other courts have held that a letter larger than other portions of a mark is the dominant portion of the mark. *Vogue Co. v. Thompson-Hudson Co.*, 300 F. 509, 3 Ohio L. Abs. 220 (6th Cir. 1924), *cert. denied*, 273 U.S. 706, 71 L. Ed. 850, 47 S. Ct. 98 (1926).

Regarding Registrant No. 2's mark, the Examining Attorney gave no weight to the large design portions of Registrant No. 2's mark, which depicts a running fox that is five times larger than any literal element. Even though design elements of a mark can be given less weight, they must still be considered in determining a likelihood of confusion. Applicant respectfully asserts that the size and active demeanor of the animal portion of this mark, would cause a consumer to focus on the logo, and not on the literal COYOTE portion which appears smaller and at the end of the mark.

**Weak portions of a mark are given less weight.**

Additionally, Applicant respectfully further asserts that the COYOTE portion of Registrants' marks are weak and the Attorney gave this portion of Registrants' marks too much weight.

Examining Attorney stated the following:

... Applicant further argues that the COYOTE mark is diluted, citing several youth instructional and amateur sports teams in this country that call themselves Coyotes. However, as the attached evidence from the USPTO's X-Search database of registered marks and pending applications shows, the only federally registered marks containing the word COYOTE for retail store services or online retail store services featuring sporting goods are W COYOTE, W COYOTE OUTDOORS, and RED COYOTE. Therefore, Registrant No 1's and Registrant No. 2's marks are strong marks for the services at issue here.

Even if the registered marks are weak marks, the Court of Appeals for the Federal Circuit and the Trademark Trial and Appeal Board have recognized that marks deemed "weak" or merely descriptive are still entitled to protection against the registration by a subsequent user of a similar mark for closely related goods and/or services.

(Final Office Action, October 16, 2014, p. 6-7) (internal citations omitted).

A basic tenet of trademark examination is that strong marks are given strong protection and weak marks are given weak protection. See e.g. *Sure-Fit Products Co. v. Saltzson Drapery Co.*, 45 C.C.P.A. 856, 254 F.2d 158, 160, 117 U.S.P.Q. 295 (1958) (Affirming dismissal of opposition by SURE-FIT against the registration of RITE-FIT, both for furniture slip-covers. "[W]here a party chooses a trademark which is inherently weak, he will not enjoy the wide latitude of protection afforded the owners of strong trademarks.").

Applicant asserts that the Examining Attorney gave too little weight to the fact that consumers would not likely focus on COYOTE in the realm of sports because of the innumerable sports teams with COYOTE emblems and mascots. See evidence attached to previous response. Although the Examining Attorney limited the analysis to sports retailers, sports retailers often sell team merchandise and most teams offer merchandise for sale in connection with their sports teams, usually at a retail shop associated with the team. Therefore, the mark COYOTE is weak when connected with sports retailers and should be given less weight than other portions of the marks.

The fact that Examining Attorney was able to cite several marks for retail store services or online retail store services featuring sporting goods, using the element “COYOTE” in their marks emphasizes that the element “COYOTE” is a common and not strong mark for identifying an online retail store. Therefore, consumers are less likely to focus on the “COYOTE” portion of the mark than on other portions of Applicant’s mark. Consumers are likely to carefully consider the context and the specific services much more cautiously when confronted with a mark comprising the term “COYOTES.”

**The Office Action gave too little weight to disclaimed portions of the mark.**

Although disclaimed portions of marks may not be the dominant portion of the mark, they must still be considered in determining likelihood of confusion. Here, the Examining Attorney gave too little weight to ICE SPORTS in relation to Applicant’s mark, even though it forms the larger portion of Applicant’s mark.

The disclaimed portion of a mark must still be considered in determining likelihood of confusion since buyers are confronted in the marketplace by the entire mark. Since infringement is determined by the likely reaction of ordinary consumers, who neither know nor care about disclaimers, a disclaimer is irrelevant in determining likelihood of confusion. *In re National Data Corp.*, 753 F.2d 1056, 1059, 224 U.S.P.Q. 749 (Fed. Cir. 1985) (“The technicality of a disclaimer in National’s application to register its mark has no legal effect on the issue of likelihood of confusion. The public is unaware of what words have been disclaimed during prosecution of the trademark application at the PTO.”); *Shen Mfg. Co., Inc. v. Ritz Hotel, Ltd.*, 393 F.3d 1238, 73 U.S.P.Q.2d 1350 (Fed. Cir. 2004) (“The disclaimed elements of a mark, however, are relevant to the assessment of similarity ....This is so because confusion is evaluated from the perspective of the purchasing public, which is not aware that certain words or phrases have been disclaimed.”).

Therefore, Applicant respectfully requests that the Examining Attorney give proper weight that ICE SPORTS of Applicant’s mark clearly distinguishes it from Registrants’ marks because ICE SPORTS refers to sports played on ice, such as hockey, curling, and figure skating, whereas Registrant No. 1 has clearly limited its registration to outdoors sports, such as fishing, hunting, and shooting, and Registrant No. 2 has clearly limited itself to running sports.

Further, in relation to Registrant No. 1’s mark “W COYOTES OUTDOORS” (with “OUTDOORS” disclaimed), Examining Attorney that “ICE SPORTS” and “OUTDOORS” create similar commercial impressions, and cites eight webpages as evidence that ice sports are often played outdoors. (Final Office Action, October 16, 2014, p. 6). First, many of the website cited by the Examining Attorney show multiple outdoor skating rinks, most of which only open during a specific season of the year and thus would not create the same commercial impression as an indoor skating rink which is open year-round. As is commonly understood, “ICE SPORTS” refers to sports played on ICE, and does not connote an outdoor sport at all. For example, the following ice skating rinks are only open during part of



the year due to their outdoor nature:

- Ice Skating & Skate Shop from Powell Rec is open “as soon as cold temperatures permit, usually mid December” (Office Action, October 16, 2014, p. 14).
- Minneapolis Park & Recreation’s Board Outdoor Skating is open “December 21, 2013 weather and conditions permitting” (Office Action, October 16, 2014, p. 15)

Moreover, geographic location can vastly change the connotation of “outdoors.” For example, many of the websites cited by the Examining Attorney are located in Alaska (Office Action, October 16, 2014, p. 18), New York (Office Action, October 16, 2014, p. 17), and Massachusetts (Office Action, October 16, 2014, p. 19). Applicant attaches evidence of websites featuring ice sports, none of which are restricted to the outdoors (see: <http://www.icesports.com/>, <http://www.bakersfieldicesports.com/public-skating>, <http://www.theicesportsforum.com/>, <http://centericesports.net/skating.html>). Second, Registrant No. 1’s mark “W COYOTES OUTDOORS” is directed to clothing items such as bandanas and shirts as well as **On-line** retail store services featuring Outdoor equipment and sport goods. In contrast, Applicant’s mark “COYOTES ICE SPORTS” is used in connection with services such as Retail stores featuring hockey and figure skating equipment. Thus, they create different commercial impressions, as a member of the public would not consider “W COYOTES OUTDOORS” as related to outdoor equipment to be related to “COYOTES ICE SPORTS” for retail stores featuring hockey and figure skating equipment.

Accordingly, based on the above outlined factors, Applicant respectfully asserts that Applicant’s and Registrants’ marks contain different dominant portions and consumers would likely not be confused based on the dissimilarities of the marks as to size, appearance, and commercial impression.

**B. The similarity or dissimilarity and nature of the goods . . . described in an application or registration or in connection with which a prior mark is in use.**

Applicant mark is used on dissimilar services from Registrants’ marks based on the different types of sports that the marks are directed to.

The nature and scope of a party’s goods or services must be determined on the basis of the goods or services recited in the application or registration. TMEP 1207.01(a)(iii). *See, e.g., Stone Lion Capital Partners, L.P. v. Lion Capital LLP*, \_\_\_ F.3d \_\_\_, 110 USPQ2d 1157, 1162 (Fed. Cir. Mar. 26, 2014); *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1370, 101 USPQ2d 1713, 1722 (Fed. Cir. 2012); *Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 1267, 62 USPQ2d 1001, 1004 (Fed. Cir. 2002); *J & J Snack Foods Corp. v. McDonald’s Corp.*, 932 F.2d 1460, 1463, 18 USPQ2d 1889, 1892 (Fed. Cir. 1991); *Octocom Sys., Inc. v. Houston Computer Servs., Inc.*, 918 F.2d 937, 942, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990); *Canadian Imperial Bank of Commerce, N.A. v. Wells Fargo Bank*, 811 F.2d 1490, 1493, 1 USPQ2d 1813, 1815 (Fed. Cir. 1987); *Paula Payne Prods. Co. v. Johnson Publ’g Co.*, 473 F.2d 901, 902, 177 USPQ 76, 77 (C.C.P.A. 1973); *In re Giovanni Food Co.*, 97 USPQ2d 1990, 1991 (TTAB 2011); *In re Iolo Techs., LLC*, 95 USPQ2d 1498, 1500 (TTAB 2010). Although Internet evidence is permissible to clarify uncertain terms in the identification of goods and services, a determination of the scope of Registrant’s mark must be made on the basis of the

identification in the registration.

Examining Attorney states that Applicant's and prior Registrant's marks are used on similar goods and services. Specifically, the Examining Attorney stated:

In this case, applicant's identified services are *retail sporting goods stores*; retail stores featuring hockey and figure skating equipment, merchandise and novelties. Registrant No. 1's identified services are *retail sporting goods stores* (Registration No. 3655451) and *online retail store services featuring outdoor equipment and sport goods* (Registration No. 368837). Registrant No. 2's identified services include *retail sporting goods stores*.

Applicant erroneously argues that it is limited in its identified services to "retail stores "featuring hockey and figure skating equipment"" and that, therefore, applicant's identified services differ from the registrants' identified services. Applicant overlooks the fact that applicant's and both registrants' identified services include "retail sporting goods store(s)." Also Registrant No.1's second mark (Registration No. 3688377) includes "on-line retail store services featuring outdoor equipment and *sport goods*."

(October 16, 2014, Final Office Action, page 7.) Applicant respectfully disagrees.

The Examining Attorney cites the similarity in identification of services as evidence that the marks are used on similar services. However, the Examining Attorney gives too little weight that Applicant has limited itself to "hockey and figure skating equipment." When considering the comparison of services, the Examining Attorney should consider the identification of services as a whole, and not consider piecemeal the portions of the identification.

Further, the Trademark Trial and Appeal Board has noted that a diversity of the goods identified in the registration diminishes the probative value in establishing that any two items identified in the registration are related. *In re Princeton Tectonics, Inc.*, 95 USPQ2d 1509 (TTAB 2010); *In re Davey Products Pty Ltd.*, 92 USPQ2d 1198, 1203 (TTAB 2009). Here, the following third-party registrations provided by the Examining Attorney have a diverse amount of goods identified in their registrations that diminishes the probative value of establishing any one or more of the identification of services are related. Besides, each of Applicant and Registrant clearly use their marks on different types of sporting goods (ice sports, outdoor sports, and running), so no confusion between consumers as the similarity of goods is likely.

The Examining Attorney incorrectly relies on the internet evidence of [www.dickssportinggoods.com](http://www.dickssportinggoods.com), [www.big5sportinggoods.com](http://www.big5sportinggoods.com), and [www.sportsauthority.com](http://www.sportsauthority.com) for the proposition that the same entity provides the relevant services and markets the services under the same mark and that the relevant services are sold or provided through the same trade channels.

Trademark Trial and Appeal Board also found that third-party registrations have no probative value



when the products or services listed in the respective descriptions of goods are **different**. See *In re Thor Tech, Inc.*, Serial No. 85667188 (January 26, 2015) (emphasis added). The case *In re Thor Tech, Inc.* found that third party registrations showing marks in connection with land motor vehicles and towable recreational vehicle trailers showed the businesses in the two industries were distinct enough to avoid confusion between even identical marks, despite the Examining Attorney's third-party registration evidence. *Id.* at 7. "Registrations tend to define fields of use and, conversely, the boundaries of use and protection surrounding the marks and marks comprising the same word....forthe various products." *In Keebler Company v. Associated Biscuits Limited*, 207 USPQ 1034 (TTAB 1980).

In *In re Princeton Tectonics, Inc.*, the Trademark Trial and Appeal Board found that only one of six third-party registrations provided by the Examining Attorney that included personal head lamps was possibly probative of showing that personal headlamps and electronic lighting fixtures are related because the primary purpose of the goods "...is to emit and provide light." 95 USPQ2d 1509 (TTAB 2010). The TTAB found that registrations that also identified other goods, such as automatic bread-making machines, rice cookers, various types of cooking ovens, ventilation systems, and air conditioners diminished the probative value in establishing any two items identified in the registration are related. *Id.* At 6-7.

Therefore, the cited internet is not probative in showing that Registrants' services and Applicants' service often emanate from a single source.

### **C. The Length of Time During and the Conditions Under Which There Has Been Concurrent Use Without Evidence of Actual Confusion**

The length of time during and the conditions under which there has been concurrent use without evidence of actual confusion is relevant to a likelihood of confusion analysis. *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361 177 USPQ 563, 567 (CCPA 1973). This factor favors Applicant.

Registrants have been using their marks with the element "COYOTES" concurrently for at least five years without evidence of actual confusion. Specifically, Registration No. 3655451 for "W COYOTE" has been registered since July 29, 2008 and was published May 6, 2008. Further, Registration No. 3688377 for "W COYOTES OUTDOORS" (with "OUTDOORS" disclaimed) has been registered since September 29, 2009, the registration of which indicates a use in commerce as early as May 1, 2008. Lastly, Registrant No. 2's mark "RED COYOTE" in Registration No. 4379914 has been registered since August 6, 2013, the registration of which indicates a use in commerce as early as March 29, 2010 and a date of first use in commerce as early as April 5, 2010.

In light of the above evidence that several entities have used marks with the element COYOTE, consumers are not likely to be confused by the registration of Applicant's mark, which contains

COYOTES as one of its literal elements. Accordingly Applicant respectfully requests the Examining Attorney to move Applicant's mark to publication.

#### **D. Conclusion**

In conclusion, Applicant respectfully asserts that all the *DuPont* factors discussed favor Applicant and that a consumer is unlikely to be confused by the simultaneous registration of Applicant's and Registrants marks. Therefore, Applicant respectfully requests that Applicant's applied-for mark be moved to publication.

#### **Specimen Refusal – Mark Differs on Drawing and Specimen**

The Examining Attorney states that registration is refused because the specimen does not show the applied-for mark in the drawings in use in commerce.

However, as Applicant has previously noted, the applied-for mark and Applicant's specimen are depicted on the same visual plane and in the same size, spacing, color and type font. "The regulation's term 'substantially' permits some inconsequential variation from the 'exact representation' standard." *In re Hacot-Columbier*, 105 F.3d 616, 41 USPQ2d 1523, 1525 (Fed. Cir. 1997). Here, Applicant's specimen constitutes at most, a minor, "inconsequential variation" between the mark as it appears on the drawing and in the specimen. The matter in question is merely a coyote's head, as opposed to wording or stylized lettering. The coyote's head has no distinctive or source-indicating function, and it has no effect on the commercial impression of Applicant's mark. The commercial impression, therefore, is that of a unitary phrase, COYOTES ICE SPORTS.

In response, Examining Attorney stated the following:

Applicant points to the decision in *In re Big Pig, Inc.*, 81 USPQ2d 1436, 1440 (TTAB 2006) to support its argument that the presence of the coyote head design on the specimen does not materially alter the mark shown in the drawing. That case, however, is not applicable here because, in that case, the literal element PSYCHO was written over the other wording and design elements, such that it stood out from the remainder of the design.

The Board explained:

[the] "Psycho" element creates separate and distinct commercial impression that indicates source of applicant's goods apart from additional words and design, in that word "Psycho" is displayed in different color, type, style, and size, such that it stands out from remainder of design and *looks like graffiti painted over logo*. (emphasis added).

In this case, the literal elements – COYOTES ICE SPORTS – are not written over the coyote head design, but rather the coyote head design is written over the literal elements, obscuring two of the letters in the only non-disclaimed word in the proposed three-word mark. Applicant cites three other cases that inapplicable here because they involve compound marks, not marks in which the mark in the drawing differed from the mark on specimen due to design elements in the specimen obscuring part of the literal elements displayed in the drawing.

(October 16, 2014, Final Office Action, p. 9). Applicant respectfully disagrees.

In contrast to the Examining Attorney's emphasis, the court in *In re Big Pig*, was not concerned with whether the mark was "over" or "under" the other mark. The court noted that the word mark "

looks like graffiti painted over the logo,” because that is what was literally shown, not the elements that the court held to be different. Instead, the factors that court relied on were whether it was displayed “in different color, type, style, and size, such that it stands out from the remainder of the design.” Here, Applicant’s mark is clearly of different color, type, style, and size. The court used the fact that the registrable mark was “over” the logo portion of the mark to indicate compliance with these factors. Notably, the court did not mention “location” or “placement” as one of the factors that it considered.

When considering these factors, Applicant’s COYOTES ICE SPORTS portion is of different color than the design portion of the mark. Applicant’s COYOTES ICE SPORTS portion is a different type than the design portion of the mark because it is a literal word element compared with a graphic element. Applicant’s COYOTES ICE SPORTS portion is a different style than the design portion because it depicted in outlined block letters whereas the graphic element is a colorized cartoon of a coyote. And, Applicant’s COYOTES ICE SPORTS portion is a different size than the design portion because it is long and narrow and extends greatly outward so as to form a separate element of the mark.

Based on an analysis of all the factors outlined in *In re Big Pig*, Applicant’s mark comprises separable elements, and Applicant respectfully asserts that the literal portion is entitled to registration.

Furthermore, the Examining Attorney stated:

Applicant cites three other cases that inapplicable here because they involve compound marks, not marks in which the mark in the drawing differed from the mark on specimen due to design elements in the specimen obscuring part of the literal elements displayed in the drawing.

Applicant respectfully disagrees. In rejecting out of hand three cases cited by Applicant, the Examining Attorney stated that Applicant’s mark was a “compound mark.” It is unclear if Examining Attorney is referring to a “composite mark.” “A “composite” **mark** may consist of a word or words combined with a design or designs; it may consist solely of words, when there are separable word elements; or it may consist solely of separable design elements.” TMEP 1213.02

Applicant respectfully asserts that the Examining Attorney has clearly identified the bounds of the mark by noting that “Specifically, the mark on the specimen contains the addition of the design of the head of a howling coyote that overlays and obscures part of the letters “Y” and “O” in COYOTES.” (October 16, 2014, Final Office Action, p. 9). This is a strong indication that the literal element of Applicant’s mark, COYOTES ICE SPORTS, is a separate and distinct portion of Applicant’s mark and entitled to registration for that reason.

Accordingly, Applicant respectfully requests that Applicant’s applied-for mark be moved forward to publication.

## EVIDENCE SECTION

EVIDENCE  
FILE NAME(S)

[\\TICRS\EXPORT16\IMAGEOUT  
16\861\351\86135128.xml10 \RFR0002.JPG](#)

[\\TICRS\EXPORT16\IMAGEOUT](#)

|  |  |
|--|--|
|  | <a href="#">16\861\351\86135128\xml10 \RFR0003.JPG</a>                               |
|  | <a href="#">\\TICRS\EXPORT16\IMAGEOUT<br/>16\861\351\86135128\xml10 \RFR0004.JPG</a> |
|  | <a href="#">\\TICRS\EXPORT16\IMAGEOUT<br/>16\861\351\86135128\xml10 \RFR0005.JPG</a> |
| <b>DESCRIPTION OF EVIDENCE FILE</b>  | Evidence   |
| <b>GOODS AND/OR SERVICES SECTION (current)</b>   |  |
| <b>INTERNATIONAL CLASS</b>   | 035  |
| <b>DESCRIPTION</b>   |  |
| Retail sporting goods stores; Retail stores featuring hockey and figure skating equipment, merchandise and novelties, namely, hockey helmets, hockey sticks, hockey gloves, hockey pads, hockey pants, hockey socks, hockey stakes, hockey apparel, hockey protective gear, hockey jerseys, hockey masks, hockey novelty items, hockey bags, hockey pucks and training aids, figure skating skates, figure skating apparel, figure skating gloves, figure skating novelty items, figure skating bags |  |
| <b>FILING BASIS</b>  | Section 1(a)   |
| <b>FIRST USE ANYWHERE DATE</b>   | At least as early as 01/15/2000  |
| <b>FIRST USE IN COMMERCE DATE</b>  | At least as early as 01/15/2000  |
| <b>GOODS AND/OR SERVICES SECTION (proposed)</b>  |  |
| <b>INTERNATIONAL CLASS</b>   | 035  |
| <b>DESCRIPTION</b>   |  |
| Retail sporting goods stores; Retail stores featuring hockey and figure skating equipment, merchandise and novelties, namely, hockey helmets, hockey sticks, hockey gloves, hockey pads, hockey pants, hockey socks, hockey stakes, hockey apparel, hockey protective gear, hockey jerseys, hockey masks, hockey novelty items, hockey bags, hockey pucks and training aids, figure skating skates, figure skating apparel, figure skating gloves, figure skating novelty items, figure skating bags |  |
| <b>FILING BASIS</b>  | Section 1(a)   |
| <b>FIRST USE ANYWHERE DATE</b>   | At least as early as 01/15/2000  |
| <b>FIRST USE IN COMMERCE DATE</b>  | At least as early as 01/15/2000  |
| <b>FILING BASIS</b>  | Section 1(b)   |
| <b>SIGNATURE SECTION</b>   |  |
| <b>DECLARATION SIGNATURE</b>   | /Steven J. Laureanti/  |
| <b>SIGNATORY'S NAME</b>  | Steven J. Laureanti  |
| <b>SIGNATORY'S POSITION</b>  | Attorney of Recrod, Arizona bar memeber  |
| <b>SIGNATORY'S PHONE NUMBER</b>  | 480-464-1111   |
|  |  |

|                                   |  |
|-----------------------------------|--|
| DATE SIGNED                       | 04/16/2015   |
| RESPONSE SIGNATURE                | /STEVEN J. LAUREANTI/  |
| SIGNATORY'S NAME                  | STEVEN J. LAUREANTI  |
| SIGNATORY'S POSITION              | Attorney of record, Arizona bar member   |
| SIGNATORY'S PHONE NUMBER          | 480-464-1111   |
| DATE SIGNED                       | 04/16/2015   |
| AUTHORIZED SIGNATORY              | YES  |
| CONCURRENT APPEAL NOTICE FILED    | YES  |
| <b>FILING INFORMATION SECTION</b> |  |
| SUBMIT DATE                       | Thu Apr 16 23:37:11 EDT 2015   |
| TEAS STAMP                        | USPTO/RFR-98.174.245.184-<br>20150416233711423428-8613<br>5128-53067dfccc6ef659f648<br>91f1d5c19543436d6d5cfebdd<br>7ed8766b1cd426e53e785-N/A<br>-N/A-20150416232833440857 |

## Request for Reconsideration after Final Action To the Commissioner for Trademarks:

Application serial no. **86135128** has been amended as follows:

### ARGUMENT(S)

**In response to the substantive refusal(s), please note the following:**

#### 1. Refusal – Trademark Act § 2(d) – Likelihood of Confusion

Applicant received a Final Office Action on October 16, 2014. The Examining Attorney has refused registration of the applied-for mark under Trademark Act Section 2(d), 15 U.S.C. § 1052, because of a likelihood of confusion with the marks in U.S. Registration Nos. 3655451, 3688377, and 4379914. The first two registrations are owned by the same entity (“Registrant No. 1”) and the third registration is owned by another entity (“Registrant No. 2”). (Office Action, October 16, 2014, p. 3). Applicant respectfully disagrees that the registered mark is confusingly similar to Registrant’s mark under Section

2(d).

Likelihood of confusion between two marks is determined on a case-by-case basis by a review of all relevant factors under the *DuPont* test. *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973). Specifically, the following thirteen factors are useful in determining whether a likelihood of confusion exists between the registered mark and the mark under examination:

1. The similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation, and commercial impression.
2. The similarity or dissimilarity and nature of the goods . . . described in an application or registration or in connection with which a prior mark is in use.
3. The similarity or dissimilarity of established, likely-to-continue trade channels.
4. The conditions under which and buyers to whom sales are made, i.e. "impulse" vs. careful, sophisticated purchasing.
5. The fame of the prior mark.
6. The number and nature of similar marks in use on similar goods.
7. The nature and extent of any actual confusion.
8. The length of time during and the conditions under which there has been concurrent use without evidence of actual confusion.
9. The variety of goods on which a mark is or is not used.
10. The market interface between the applicant and the owner of a prior mark.
11. The extent to which applicant has a right to exclude others from use of its mark on its goods.
12. The extent of potential confusion.
13. Any other established fact probative of the effect of use.

*In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361 177 USPQ 563, 567 (CCPA 1973). The two key considerations in ex parte likelihood of confusion analysis are the similarity of the marks and the similarity of the goods. *See Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976). Not all of the *DuPont* factors may be relevant or of equal weight in a given case, and any one of the factors may control a particular case depending on the evidence of record. *Citigroup Inc. v. Capital City Bank Grp., Inc.*, 637 F.3d at 1355, 98 USPQ2d at 1260; *In re Majestic Distilling Co.*, 315 F.3d 1311, 1315, 65 USPQ2d 1201, 1204 (Fed. Cir. 2003); *see In re E. I. du Pont de Nemours & Co.*, 476 F.2d at 1361-62, 177 USPQ at 567.

In the present dispute, the most important *DuPont* factors are 1, 2, and 8. Each will be discussed in turn.

**A. The similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation, and commercial impression.**

Applicant's mark "COYOTES ICE SPORTS" has a different sound, appearance, and connotation from Registrant's marks. Examining Attorney errs by placing too much weight on the common material, to the



point that Examining Attorney effectively fails to consider the marks as a whole. Instead, the Examining Attorney relies only on the material in common, and does not analyze the material differences between the marks. Even if the analysis did properly consider the marks as a whole, it did not correctly identify the dominant portion of the marks.

In failing to analyze the marks as a whole, the Examining Attorney gave no weight to disclaimed material. The law is long settled that a disclaimer does not remove the disclaimed matter from the mark. The mark must still be regarded as a whole, including the disclaimed matter, in evaluating similarity to other marks. See *In re Nat'l Data Corp.*, 753 F.2d 1056, 1059, 224 USPQ 749, 751 (Fed. Cir. 1985); *Specialty Brands, Inc. v. Coffee Bean Distribs., Inc.*, 748 F.2d 669, 672, 223 USPQ 1281, 1282 (Fed. Cir. 1984); *Giant Food, Inc. v. Nation's Foodservice, Inc.*, 710 F.2d 1565, 1570, 218 USPQ 390, 395 (Fed. Cir. 1983); *Schwarzkopf v. John H. Breck, Inc.*, 340 F.2d 978, 144 USPQ 433 (C.C.P.A. 1965); *In re MCI Commc'ns Corp.*, 21 USPQ2d 1534, 1538-39 (Comm'r Pats. 1991). "The commercial impression of a trade-mark is derived from it as a whole, not from its elements separated and considered in detail. For this reason it should be considered in its entirety ....") *Estate of P.D. Beckwith, Inc., v. Commissioner of Patents*, 252 U.S. 538, 545-46, 40 S. Ct. 414, 64 L. Ed. 705 (1920). *Massey Junior College, Inc. v. Fashion Institute of Technology*, 492 F.2d 1399, 181 U.S.P.Q. 272 (C.C.P.A. 1974). See also, *Franklin Mint Corp. v. Master Mfg. Co.*, 667 F.2d 1005, 212 U.S.P.Q. 233 (C.C.P.A. 1981) ("It is axiomatic that a mark should not be dissected and considered piecemeal; rather, it must be considered as a whole in determining likelihood of confusion."); and *Sun-Fun Products, Inc. v. Suntan Research & Development, Inc.*, 656 F.2d 186, 213 U.S.P.Q. 91 (5th Cir. 1981) (the test is "overall impression," not a "dissection of individual features").

In the previous Office Actions, the Examiner did not consider the overall impression that W, OUTDOORS, RED, or the design portion of a fox contributed to the marks. Instead the Examining Attorney stated:

Registrant No. 1's other mark, W COYOTE, has no disclaimed words. Applicant's mark merely discards the letter W in Registrant No. 1's mark and adds the descriptive words ICE SPORTS. Adding a term to a registered mark generally does not obviate the similarity between the compared marks, as in the present case, nor does it overcome a likelihood of confusion under Section 2(d). See *Coca-Cola Bottling Co. v. Jos. E. Seagram & Sons, Inc.*, 526 F.2d 556, 557, 188 USPQ 105, 106 (C.C.P.A. 1975) (finding BENGAL and BENGAL LANCER and design confusingly similar).

Likewise, Registrant No. 2's mark, RED COYOTE, has no disclaimed words. Applicant's mark merely discards the word RED in Registrant No. 2's mark and adds the descriptive words ICE SPORTS. Again such a substitution does not obviate the similarity between the compared marks, nor does it overcome a likelihood of confusion under Section 2(d).

(October 16, 2014, Final Office Action, page 5.)

The problem with the Examiner's analysis and reliance on *Coca-Cola Bottling Co. v. Jos. E. Seagram & Sons, Inc.* is that, in that case, the dominant portion of the mark was also the first portion of the mark. There, the Applicant merely added a modifying word to the end of a mark, where the first portion of

the mark was the dominant portion. Besides, simply because two marks share similar portions is not the test of whether likelihood of confusion exists. *Conde Nast Publications, Inc. v. Miss Quality, Inc.*, 507 F.2d 1404, 184 U.S.P.Q. 422 (C.C.P.A. 1975) (COUNTRY VOGUES not confusingly similar to VOGUE); *In re Merchandising Motivation, Inc.*, 184 U.S.P.Q. 364 (T.T.A.B. 1974) (there is no absolute rule that no one has the right to incorporate the total mark of another as a part of one's own mark: MMI MENSWEAR not confusingly similar to MEN'S WEAR); *Plus Products v. General Mills, Inc.*, 188 U.S.P.Q. 520 (T.T.A.B. 1975) (PROTEIN PLUS and PLUS not confusingly similar).

Here, Applicant's did not merely append a word to the end of either Registrant's mark, but instead seek registration of a mark with a different first portion and different final portion than either of them. It has long been settled the dominant portion of a literal mark is most often the first portion because it is the portion that is most likely to stick into consumer's minds.

Applicant respectfully asserts that the dominant portion of the marks to Registrant No. 1 is the "W" portion of the mark based on its larger size than any other letter and its position at the beginning of the mark. Applicant respectfully asserts that the dominant portion of the mark to Registrant No. 2 is the first literal element RED or the graphical portion of the mark based on its larger size and the distinctive character of the design.

#### **The first portion of a mark should be given greater weight.**

The Examining Attorney instead held that the literal portions of the marks, COYOTE, is the dominant portion of the registered marks. However, it has long been settled that consumers are most likely to focus on the *first part* of a mark.

"[T]here is more apt to be infringement where there is similarity, ...in the front part of the trademark. That part comes first, is the most prominent, and it is likely to be dominating." *Coca-Cola Co. v. Carlisle Bottling Works*, 43 F.2d 101 (E.D. Ky. 1929), *aff'd*, 43 F.2d 119 (6th Cir. 1930), *cert. denied*, 282 U.S. 882, 75 L. Ed. 778, 51 S. Ct. 86 (1930). See also, *Presto Products, Inc. v. Nice-Pak Products, Inc.*, 9 U.S.P.Q.2d 1895 (T.T.A.B. 1988) ("[I]t is often the first part of a mark which is most likely to be impressed upon the mind of a purchaser and remembered." KID-WIPES held confusingly similar to KID STUFF both for baby wipes.); *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 U.S.P.Q.2d 1689 (Fed. Cir. 2005) (In the mark VEUVE CLIQUOT, VEUVE is a "prominent feature" because it is the first word in the mark as well as the first word to appear on the wine label.); *In re Paper Doll Promotions, Inc.*, 84 U.S.P.Q.2d 1660, 2007 WL 2344667 (T.T.A.B. 2007) (first part of mark is dominant: likelihood of confusion in PAPER DOLL (and design) v. PAPER DOLL PROMOTIONS); *Eveready Battery Company, Inc. v. Green Planet, Inc.*, 91 U.S.P.Q.2d 1511, 2009 WL 2176668 (T.T.A.B. 2009) (That the word SLICK is first in the accused mark SLICK ULTRA PLUS is evidence that it is the dominant part. A likelihood of confusion with the senior user's SCHICK was found for the same goods.)

Accordingly, the present case is similar to the KID-WIPES, VEUVE CLIQUOT, and PAPER DOLL

PROMOTIONS cases, because the dominant portion of the marks is the first portion. Therefore, consumers would focus on the W portion of Registrant No. 1's marks and the RED portion of Registrant No. 2's mark, not on the COYOTE portion of those marks. The W and RED portion of those marks form the dominant portion of those marks.

Therefore, Applicant respectfully asserts that when the dominant portions of the marks are compared, COYOTES, of Applicant's mark with W and RED of Registrants' marks, no likelihood of confusion can be found.

**The largest portion of a mark should be given greater weight.**

If the Examining Attorney looks to size as to determine the dominant portion of the mark, the W portion of Registrant No. 1's marks is much larger than any other character of the marks. (It is at least three times as big as any other letter). Other courts have held that a letter larger than other portions of a mark is the dominant portion of the mark. *Vogue Co. v. Thompson-Hudson Co.*, 300 F. 509, 3 Ohio L. Abs. 220 (6th Cir. 1924), cert. denied, 273 U.S. 706, 71 L. Ed. 850, 47 S. Ct. 98 (1926).

Regarding Registrant No. 2's mark, the Examining Attorney gave no weight to the large design portions of Registrant No. 2's mark, which depicts a running fox that is five times larger than any literal element. Even though design elements of a mark can be given less weight, they must still be considered in determining a likelihood of confusion. Applicant respectfully asserts that the size and active demeanor of the animal portion of this mark, would cause a consumer to focus on the logo, and not on the literal COYOTE portion which appears smaller and at the end of the mark.

**Weak portions of a mark are given less weight.**

Additionally, Applicant respectfully further asserts that the COYOTE portion of Registrants' marks are weak and the Attorney gave this portion of Registrants' marks too much weight.

Examining Attorney stated the following:

... Applicant further argues that the COYOTE mark is diluted, citing several youth instructional and amateur sports teams in this country that call themselves Coyotes. However, as the attached evidence from the USPTO's X-Search database of registered marks and pending applications shows, the only federally registered marks containing the word COYOTE for retail store services or online retail store services featuring sporting goods are W COYOTE, W COYOTE OUTDOORS, and RED COYOTE. Therefore, Registrant No 1's and Registrant No. 2's marks are strong marks for the services at issue here.

Even if the registered marks are weak marks, the Court of Appeals for the Federal Circuit and the Trademark Trial and Appeal Board have recognized that marks deemed "weak" or merely descriptive are still entitled to protection against the registration by a subsequent user of a similar mark for closely related goods and/or services.

(Final Office Action, October 16, 2014, p. 6-7) (internal citations omitted).

A basic tenet of trademark examination is that strong marks are given strong protection and weak marks are given weak protection. See e.g. *Sure-Fit Products Co. v. Saltzson Drapery Co.*, 45 C.C.P.A. 856, 254 F.2d 158, 160, 117 U.S.P.Q. 295 (1958) (Affirming dismissal of opposition by SURE-FIT against the registration of RITE-FIT, both for furniture slip-covers. “[W]here a party chooses a trademark which is inherently weak, he will not enjoy the wide latitude of protection afforded the owners of strong trademarks.”).

Applicant asserts that the Examining Attorney gave too little weight to the fact that consumers would not likely focus on COYOTE in the realm of sports because of the innumerable sports teams with COYOTE emblems and mascots. See evidence attached to previous response. Although the Examining Attorney limited the analysis to sports retailers, sports retailers often sell team merchandise and most teams offer merchandise for sale in connection with their sports teams, usually at a retail shop associated with the team. Therefore, the mark COYOTE is weak when connected with sports retailers and should be given less weight than other portions of the marks.

The fact that Examining Attorney was able to cite several marks for retail store services or online retail store services featuring sporting goods, using the element “COYOTE” in their marks emphasizes that the element “COYOTE” is a common and not strong mark for identifying an online retail store. Therefore, consumers are less likely to focus on the “COYOTE” portion of the mark than on other portions of Applicant’s mark. Consumers are likely to carefully consider the context and the specific services much more cautiously when confronted with a mark comprising the term “COYOTES.”

**The Office Action gave too little weight to disclaimed portions of the mark.**

Although disclaimed portions of marks may not be the dominant portion of the mark, they must still be considered in determining likelihood of confusion. Here, the Examining Attorney gave too little weight to ICE SPORTS in relation to Applicant’s mark, even though it forms the larger portion of Applicant’s mark.

The disclaimed portion of a mark must still be considered in determining likelihood of confusion since buyers are confronted in the marketplace by the entire mark. Since infringement is determined by the likely reaction of ordinary consumers, who neither know nor care about disclaimers, a disclaimer is irrelevant in determining likelihood of confusion. *In re National Data Corp.*, 753 F.2d 1056, 1059, 224 U.S.P.Q. 749 (Fed. Cir. 1985) (“The technicality of a disclaimer in National’s application to register its mark has no legal effect on the issue of likelihood of confusion. The public is unaware of what words have been disclaimed during prosecution of the trademark application at the PTO.”); *Shen Mfg. Co., Inc. v. Ritz Hotel, Ltd.*, 393 F.3d 1238, 73 U.S.P.Q.2d 1350 (Fed. Cir. 2004) (“The disclaimed elements of a mark, however, are relevant to the assessment of similarity ... This is so because confusion is evaluated from the perspective of the purchasing public, which is not aware that certain words or phrases have been

disclaimed.”).

Therefore, Applicant respectfully requests that the Examining Attorney give proper weight that ICE SPORTS of Applicant’s mark clearly distinguishes it from Registrants’ marks because ICE SPORTS refers to sports played on ice, such as hockey, curling, and figure skating, whereas Registrant No. 1 has clearly limited its registration to outdoors sports, such as fishing, hunting, and shooting, and Registrant No. 2 has clearly limited itself to running sports.

Further, in relation to Registrant No. 1’s mark “W COYOTES OUTDOORS” (with “OUTDOORS” disclaimed), Examining Attorney that “ICE SPORTS” and “OUTDOORS” create similar commercial impressions, and cites eight webpages as evidence that ice sports are often played outdoors. (Final Office Action, October 16, 2014, p. 6). First, many of the website cited by the Examining Attorney show multiple outdoor skating rinks, most of which only open during a specific season of the year and thus would not create the same commercial impression as an indoor skating rink which is open year-round. As is commonly understood, “ICE SPORTS” refers to sports played on ICE, and does not connote an outdoor sport at all. For example, the following ice skating rinks are only open during part of the year due to their outdoor nature:

- Ice Skating & Skate Shop from Powell Rec is open “as soon as cold temperatures permit, usually mid December” (Office Action, October 16, 2014, p. 14).
- Minneapolis Park & Recreation’s Board Outdoor Skating is open “December 21, 2013 weather and conditions permitting” (Office Action, October 16, 2014, p. 15)

Moreover, geographic location can vastly change the connotation of “outdoors.” For example, many of the websites cited by the Examining Attorney are located in Alaska (Office Action, October 16, 2014, p. 18), New York (Office Action, October 16, 2014, p. 17), and Massachusetts (Office Action, October 16, 2014, p. 19). Applicant attaches evidence of websites featuring ice sports, none of which are restricted to the outdoors (see: <http://www.icesports.com/>, <http://www.bakersfieldicesports.com/public-skating>, <http://www.theicesportsforum.com/>, <http://centericesports.net/skating.html>). Second, Registrant No. 1’s mark “W COYOTES OUTDOORS” is directed to clothing items such as bandanas and shirts as well as *On-line* retail store services featuring Outdoor equipment and sport goods. In contrast, Applicant’s mark “COYOTES ICE SPORTS” is used in connection with services such as Retail stores featuring hockey and figure skating equipment. Thus, they create different commercial impressions, as a member of the public would not consider “W COYOTES OUTDOORS” as related to outdoor equipment to be related to “COYOTES ICE SPORTS” for retail stores featuring hockey and figure skating equipment.

Accordingly, based on the above outlined factors, Applicant respectfully asserts that Applicant’s and Registrants’ marks contain different dominant portions and consumers would likely not be confused based on the dissimilarities of the marks as to size, appearance, and commercial impression.

**B. The similarity or dissimilarity and nature of the goods . . . described in an application or registration or in connection with which a prior mark is in use.**

Applicant mark is used on dissimilar services from Registrants’ marks based on the different types of

sports that the marks are directed to.

The nature and scope of a party's goods or services must be determined on the basis of the goods or services recited in the application or registration. TMEP 1207.01(a)(iii). *See, e.g., Stone Lion Capital Partners, L.P. v. Lion Capital LLP*, \_\_\_ F.3d \_\_\_, 110 USPQ2d 1157, 1162 (Fed. Cir. Mar. 26, 2014); *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1370, 101 USPQ2d 1713, 1722 (Fed. Cir. 2012); *Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 1267, 62 USPQ2d 1001, 1004 (Fed. Cir. 2002); *J & J Snack Foods Corp. v. McDonald's Corp.*, 932 F.2d 1460, 1463, 18 USPQ2d 1889, 1892 (Fed. Cir. 1991); *Octocom Sys., Inc. v. Houston Computer Servs., Inc.*, 918 F.2d 937, 942, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990); *Canadian Imperial Bank of Commerce, N.A. v. Wells Fargo Bank*, 811 F.2d 1490, 1493, 1 USPQ2d 1813, 1815 (Fed. Cir. 1987); *Paula Payne Prods. Co. v. Johnson Publ'g Co.*, 473 F.2d 901, 902, 177 USPQ 76, 77 (C.C.P.A. 1973); *In re Giovanni Food Co.*, 97 USPQ2d 1990, 1991 (TTAB 2011); *In re Iolo Techs., LLC*, 95 USPQ2d 1498, 1500 (TTAB 2010). Although Internet evidence is permissible to clarify uncertain terms in the identification of goods and services, a determination of the scope of Registrant's mark must be made on the basis of the identification in the registration.

Examining Attorney states that Applicant's and prior Registrant's marks are used on similar goods and services. Specifically, the Examining Attorney stated:

In this case, applicant's identified services are *retail sporting goods stores*; retail stores featuring hockey and figure skating equipment, merchandise and novelties. Registrant No. 1's identified services are *retail sporting goods stores* (Registration No. 3655451) and *online retail store services featuring outdoor equipment and sport goods* (Registration No. 368837). Registrant No. 2's identified services include *retail sporting goods stores*.

Applicant erroneously argues that it is limited in its identified services to "retail stores "featuring hockey and figure skating equipment"" and that, therefore, applicant's identified services differ from the registrants' identified services. Applicant overlooks the fact that applicant's and both registrants' identified services include "retail sporting goods store(s)." Also Registrant No.1's second mark (Registration No. 3688377) includes "on-line retail store services featuring outdoor equipment and *sport goods*."

(October 16, 2014, Final Office Action, page 7.) Applicant respectfully disagrees.

The Examining Attorney cites the similarity in identification of services as evidence that the marks are used on similar services. However, the Examining Attorney gives too little weight that Applicant has limited itself to "hockey and figure skating equipment." When considering the comparison of services, the Examining Attorney should consider the identification of services as a whole, and not consider piecemeal the portions of the identification.

Further, the Trademark Trial and Appeal Board has noted that a diversity of the goods identified in the registration diminishes the probative value in establishing that any two items identified in the registration



are related. *In re Princeton Tectonics, Inc.*, 95 USPQ2d 1509 (TTAB 2010); *In re Davey Products Pty Ltd.*, 92 USPQ2d 1198, 1203 (TTAB 2009). Here, the following third-party registrations provided by the Examining Attorney have a diverse amount of goods identified in their registrations that diminishes the probative value of establishing any one or more of the identification of services are related. Besides, each of Applicant and Registrant clearly use their marks on different types of sporting goods (ice sports, outdoor sports, and running), so no confusion between consumers as the similarity of goods is likely.

The Examining Attorney incorrectly relies on the internet evidence of [www.dickssportinggoods.com](http://www.dickssportinggoods.com), [www.big5sportinggoods.com](http://www.big5sportinggoods.com), and [www.sportsauthority.com](http://www.sportsauthority.com) for the proposition that the same entity provides the relevant services and markets the services under the same mark and that the relevant services are sold or provided through the same trade channels.

Trademark Trial and Appeal Board also found that third-party registrations have no probative value when the products or services listed in the respective descriptions of goods are **different**. See *In re Thor Tech, Inc.*, Serial No. 85667188 (January 26, 2015) (emphasis added). The case *In re Thor Tech, Inc.* found that third party registrations showing marks in connection with land motor vehicles and towable recreational vehicle trailers showed the businesses in the two industries were distinct enough to avoid confusion between even identical marks, despite the Examining Attorney's third-party registration evidence. *Id.* at 7. "Registrations tend to define fields of use and, conversely, the boundaries of use and protection surrounding the marks and marks comprising the same word....forthe various products." *In Keebler Company v. Associated Biscuits Limited*, 207 USPQ 1034 (TTAB 1980).

In *In re Princeton Tectonics, Inc.*, the Trademark Trial and Appeal Board found that only one of six third-party registrations provided by the Examining Attorney that included personal head lamps was possibly probative of showing that personal headlamps and electronic lighting fixtures are related because the primary purpose of the goods "...is to emit and provide light." 95 USPQ2d 1509 (TTAB 2010). The TTAB found that registrations that also identified other goods, such as automatic bread-making machines, rice cookers, various types of cooking ovens, ventilation systems, and air conditioners diminished the probative value in establishing any two items identified in the registration are related. *Id.* At 6-7.

Therefore, the cited internet is not probative in showing that Registrants' services and Applicants' service often emanate from a single source.

### **C. The Length of Time During and the Conditions Under Which There Has Been Concurrent Use Without Evidence of Actual Confusion**

The length of time during and the conditions under which there has been concurrent use without evidence of actual confusion is relevant to a likelihood of confusion analysis. *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361 177 USPQ 563, 567 (CCPA 1973). This factor favors Applicant.

Registrants have been using their marks with the element “COYOTES” concurrently for at least five years without evidence of actual confusion. Specifically, Registration No. 3655451 for “W COYOTE” has been registered since July 29, 2008 and was published May 6, 2008. Further, Registration No. 3688377 for “W COYOTES OUTDOORS” (with “OUTDOORS” disclaimed) has been registered since September 29, 2009, the registration of which indicates a use in commerce as early as May 1, 2008. Lastly, Registrant No. 2’s mark “RED COYOTE” in Registration No. 4379914 has been registered since August 6, 2013, the registration of which indicates a use in commerce as early as March 29, 2010 and a date of first use in commerce as early as April 5, 2010.

In light of the above evidence that several entities have used marks with the element COYOTE, consumers are not likely to be confused by the registration of Applicant’s mark, which contains COYOTES as one of its literal elements. Accordingly Applicant respectfully requests the Examining Attorney to move Applicant’s mark to publication.

#### **D. Conclusion**

In conclusion, Applicant respectfully asserts that all the *DuPont* factors discussed favor Applicant and that a consumer is unlikely to be confused by the simultaneous registration of Applicant’s and Registrants marks. Therefore, Applicant respectfully requests that Applicant’s applied-for mark be moved to publication.

#### **Specimen Refusal – Mark Differs on Drawing and Specimen**

The Examining Attorney states that registration is refused because the specimen does not show the applied-for mark in the drawings in use in commerce.

However, as Applicant has previously noted, the applied-for mark and Applicant’s specimen are depicted on the same visual plane and in the same size, spacing, color and type font. “The regulation’s term ‘substantially’ permits some inconsequential variation from the ‘exact representation’ standard.” *In re Hacot-Columbier*, 105 F.3d 616, 41 USPQ2d 1523, 1525 (Fed. Cir. 1997). Here, Applicant’s specimen constitutes at most, a minor, “inconsequential variation” between the mark as it appears on the drawing and in the specimen. The matter in question is merely a coyote’s head, as opposed to wording or stylized lettering. The coyote’s head has no distinctive or source-indicating function, and it has no effect on the commercial impression of Applicant’s mark. The commercial impression, therefore, is that of a unitary phrase, COYOTES ICE SPORTS.

In response, Examining Attorney stated the following:

Applicant points to the decision in *In re Big Pig, Inc.*, 81 USPQ2d 1436, 1440 (TTAB 2006) to support its argument that the presence of the coyote head design on the specimen does not materially alter the mark shown in the drawing. That case, however, is not applicable here because, in that case, the literal element PSYCHO was written over the other wording and design elements, such that it stood out from the remainder of the design. The Board explained:

[the] “Psycho” element creates separate and distinct commercial impression that indicates source of applicant’s goods apart from additional words and design, in that word “Psycho” is displayed in different color,

type, style, and size, such that it stands out from remainder of design and *looks like graffiti painted over logo*. (emphasis added).

In this case, the literal elements – COYOTES ICE SPORTS – are not written over the coyote head design, but rather the coyote head design is written over the literal elements, obscuring two of the letters in the only non-disclaimed word in the proposed three-word mark. Applicant cites three other cases that inapplicable here because they involve compound marks, not marks in which the mark in the drawing differed from the mark on specimen due to design elements in the specimen obscuring part of the literal elements displayed in the drawing.

(October 16, 2014, Final Office Action, p. 9). Applicant respectfully disagrees.

In contrast to the Examining Attorney's emphasis, the court in *In re Big Pig*, was not concerned with whether the mark was "over" or "under" the other mark. The court noted that the word mark "*looks like graffiti painted over the logo*," because that is what was literally shown, not the elements that the court held to be different. Instead, the factors that court relied on were whether it was displayed "in different color, type, style, and size, such that it stands out from the remainder of the design." Here, Applicant's mark is clearly of different color, type, style, and size. The court used the fact that the registrable mark was "over" the logo portion of the mark to indicate compliance with these factors. Notably, the court did not mention "location" or "placement" as one of the factors that it considered.

When considering these factors, Applicant's COYOTES ICE SPORTS portion is of different color than the design portion of the mark. Applicant's COYOTES ICE SPORTS portion is a different type than the design portion of the mark because it is a literal word element compared with a graphic element. Applicant's COYOTES ICE SPORTS portion is a different style than the design portion because it depicted in outlined block letters whereas the graphic element is a colorized cartoon of a coyote. And, Applicant's COYOTES ICE SPORTS portion is a different size than the design portion because it is long and narrow and extends greatly outward so as to form a separate element of the mark.

Based on an analysis of all the factors outlined in *In re Big Pig*, Applicant's mark comprises separable elements, and Applicant respectfully asserts that the literal portion is entitled to registration.

Furthermore, the Examining Attorney stated:

Applicant cites three other cases that inapplicable here because they involve compound marks, not marks in which the mark in the drawing differed from the mark on specimen due to design elements in the specimen obscuring part of the literal elements displayed in the drawing.

Applicant respectfully disagrees. In rejecting out of hand three cases cited by Applicant, the Examining Attorney stated that Applicant's mark was a "compound mark." It is unclear if Examining Attorney is referring to a "composite mark." "A "composite" **mark** may consist of a word or words combined with a design or designs; it may consist solely of words, when there are separable word elements; or it may consist solely of separable design elements." TMEP 1213.02

Applicant respectfully asserts that the Examining Attorney has clearly identified the bounds of the mark by noting that "Specifically, the mark on the specimen contains the addition of the design of the head of a howling coyote that overlays and obscures part of the letters "Y" and "O" in COYOTES."

(October 16, 2014, Final Office Action, p. 9). This is a strong indication that the literal element of Applicant's mark, COYOTES ICE SPORTS, is a separate and distinct portion of Applicant's mark and entitled to registration for that reason.

Accordingly, Applicant respectfully requests that Applicant's applied-for mark be moved forward to publication.

## **EVIDENCE**

Evidence in the nature of Evidence has been attached. [Evidence-1](#)

[Evidence-2](#)

[Evidence-3](#)

[Evidence-4](#)

## **CLASSIFICATION AND LISTING OF GOODS/SERVICES**

**Applicant proposes to amend the following class of goods/services in the application:**

**Current:** Class 035 for Retail sporting goods stores; Retail stores featuring hockey and figure skating equipment, merchandise and novelties, namely, hockey helmets, hockey sticks, hockey gloves, hockey pads, hockey pants, hockey socks, hockey stakes, hockey apparel, hockey protective gear, hockey jerseys, hockey masks, hockey novelty items, hockey bags, hockey pucks and training aids, figure skating skates, figure skating apparel, figure skating gloves, figure skating novelty items, figure skating bags

Original Filing Basis:

**Filing Basis: Section 1(a), Use in Commerce:** The applicant is using the mark in commerce, or the applicant's related company or licensee is using the mark in commerce, on or in connection with the identified goods and/or services. 15 U.S.C. Section 1051(a), as amended. The mark was first used at least as early as 01/15/2000 and first used in commerce at least as early as 01/15/2000 , and is now in use in such commerce.

**Proposed:** Class 035 for Retail sporting goods stores; Retail stores featuring hockey and figure skating equipment, merchandise and novelties, namely, hockey helmets, hockey sticks, hockey gloves, hockey pads, hockey pants, hockey socks, hockey stakes, hockey apparel, hockey protective gear, hockey jerseys, hockey masks, hockey novelty items, hockey bags, hockey pucks and training aids, figure skating skates, figure skating apparel, figure skating gloves, figure skating novelty items, figure skating bags

**Filing Basis: Section 1(b), Intent to Use:** The applicant has a bona fide intention to use or use through the applicant's related company or licensee the mark in commerce on or in connection with the identified goods and/or services as of the filing date of the application. (15 U.S.C. Section 1051(b)).

**Filing Basis: Section 1(a), Use in Commerce:** The applicant is using the mark in commerce, or the applicant's related company or licensee is using the mark in commerce, on or in connection with the identified goods and/or services. 15 U.S.C. Section 1051(a), as amended. The mark was first used at least as early as 01/15/2000 and first used in commerce at least as early as 01/15/2000 , and is now in use in such commerce.

## **SIGNATURE(S)**

### **Declaration Signature**

DECLARATION: The signatory being warned that willful false statements and the like are punishable by fine or imprisonment, or both, under 18 U.S.C. Section 1001, and that such willful false statements and the like may jeopardize the validity of the application or submission or any registration resulting therefrom, declares that, if the applicant submitted the application or amendment to allege use (AAU) unsigned, all statements in the application or AAU and this submission based on the signatory's own knowledge are

true, and all statements in the application or AAU and this submission made on information and belief are believed to be true.

**STATEMENTS FOR UNSIGNED SECTION 1(a) APPLICATION/AAU:** If the applicant filed an unsigned application under 15 U.S.C. Section 1051(a) or AAU under 15 U.S.C. Section 1051(c), the signatory additionally believes that: the applicant is the owner of the trademark/service mark sought to be registered; the applicant or the applicant's related company or licensee is using the mark in commerce and has been using the mark in commerce as of the filing date of the application or AAU on or in connection with the goods/services in the application or AAU, and such use by the applicant's related company or licensee inures to the benefit of the applicant; the original specimen(s), if applicable, shows the mark in use in commerce as of the filing date of the application or AAU on or in connection with the goods/services in the application or AAU; and to the best of the signatory's knowledge and belief, no other person has the right to use the mark in commerce, either in the identical form or in such near resemblance as to be likely, when used on or in connection with the goods/services of such other person, to cause confusion or mistake, or to deceive.

**STATEMENTS FOR UNSIGNED SECTION 1(b)/SECTION 44 APPLICATION:** If the applicant filed an unsigned application under 15 U.S.C. Section 1051(b), Section 1126(d), and/or Section 1126(e), the signatory additionally believes that: the applicant is entitled to use the mark in commerce; the applicant has a bona fide intention and has had a bona fide intention as of the application filing date to use or use through the applicant's related company or licensee the mark in commerce on or in connection with the goods/services in the application; and to the best of the signatory's knowledge and belief, no other person has the right to use the mark in commerce, either in the identical form or in such near resemblance as to be likely, when used on or in connection with the goods/services of such other person, to cause confusion or mistake, or to deceive.

Signature: /Steven J. Laureanti/     Date: 04/16/2015  
Signatory's Name: Steven J. Laureanti  
Signatory's Position: Attorney of Record, Arizona bar member  
Signatory's Phone Number: 480-464-1111

**Request for Reconsideration Signature**

Signature: /Steven J. Laureanti/     Date: 04/16/2015  
Signatory's Name: Steven J. Laureanti  
Signatory's Position: Attorney of record, Arizona bar member

Signatory's Phone Number: 480-464-1111

The signatory has confirmed that he/she is an attorney who is a member in good standing of the bar of the highest court of a U.S. state, which includes the District of Columbia, Puerto Rico, and other federal territories and possessions; and he/she is currently the applicant's attorney or an associate thereof; and to the best of his/her knowledge, if prior to his/her appointment another U.S. attorney or a Canadian attorney/agent not currently associated with his/her company/firm previously represented the applicant in this matter: (1) the applicant has filed or is concurrently filing a signed revocation of or substitute power of attorney with the USPTO; (2) the USPTO has granted the request of the prior representative to withdraw; (3) the applicant has filed a power of attorney appointing him/her in this matter; or (4) the applicant's appointed U.S. attorney or Canadian attorney/agent has filed a power of attorney appointing him/her as an associate attorney in this matter.

The applicant is filing a Notice of Appeal in conjunction with this Request for Reconsideration.

Serial Number: 86135128

Internet Transmission Date: Thu Apr 16 23:37:11 EDT 2015

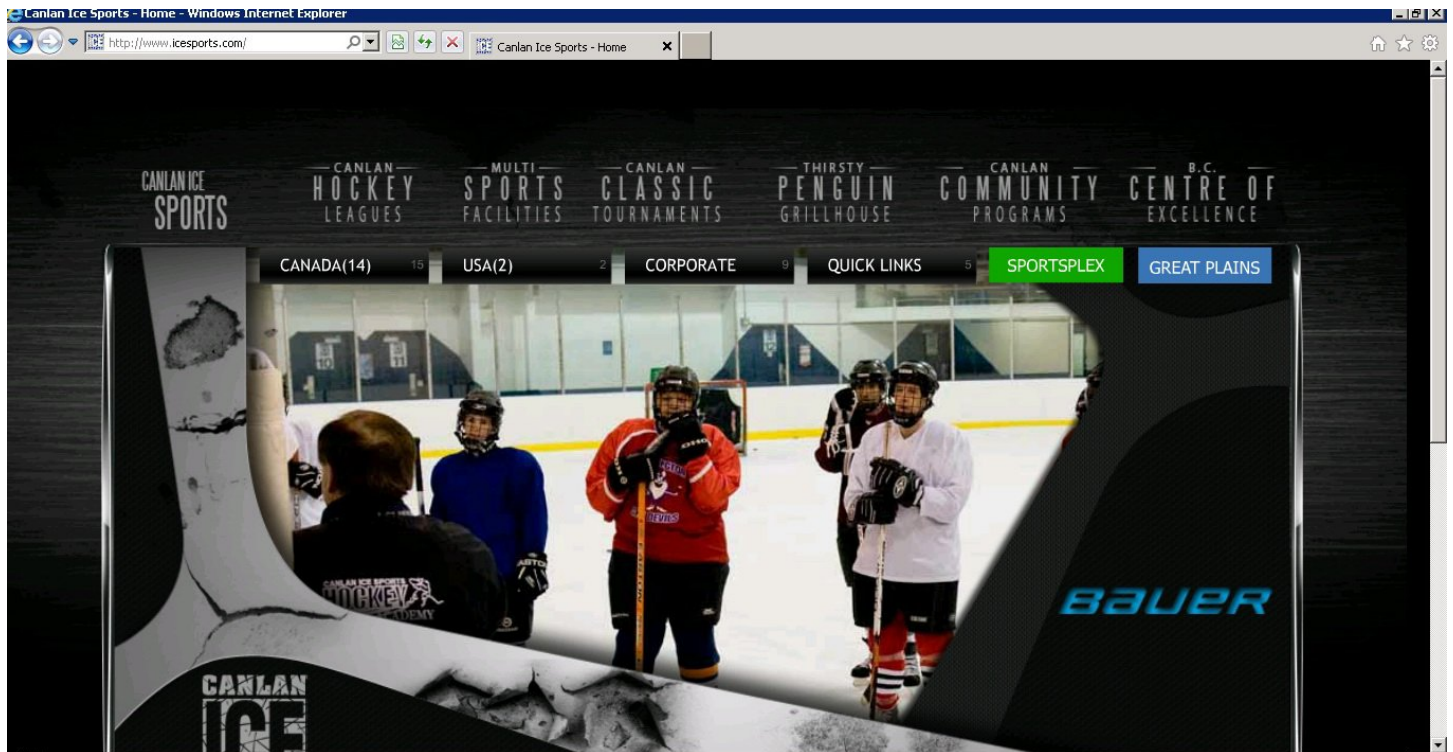
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